

REMARKS

As a preliminary matter, Applicant thanks the Examiner for withdrawing the rejections under 35 U.S.C. §§ 101 and 112, second paragraph.

Claims 1-20 remain pending in the application, with claims 1, 7, and 13 being in independent form.

In the Final Office Action¹ the Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,148,291 to Radican ("*Radican*") in view of U.S. Patent No. 5,216,620 to Sansone ("*Sansone*"), and further in view of Official Notice.

§ 103(a) Rejection

Applicant respectfully submits that the Section 103(a) rejection of claims 1-20 should be withdrawn because *Radican*, *Sansone*, and the Official Notice (which Applicant contends is improper), taken alone or in combination, fail to disclose or suggest every claim element in these claims. Applicant respectfully submits that the Final Office Action failed to provide adequate rationales to support a conclusion of obviousness in this case because the Final Office Action did not properly ascertain the scope and content of the cited references, and because there are significant differences between the teachings of the cited references and the claims, as a whole. M.P.E.P. § 2141 (II, III) ("The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'") (internal citations omitted).

¹ The Final Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

Claim 1 recites a method of tracking a tray of items, including, among other things, "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label."

The Examiner does not allege *Radican* teach or otherwise suggest "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier;" however, the Examiner alleges that *Radican* discloses "an embodiment utilizing 'enhanced' label technology for container application (column 13, lines 18-30)." (Final Office Action at p.4). This is incorrect. The cited portion of *Radican* is generally directed to the use of radio frequency identification tags and readers for tracking of shipping containers. The cited portion does not teach or otherwise suggest the use of "an enhanced label," or "[an] enhanced label comprising a routing code and a label unique identifier." Therefore, *Radican* does not disclose "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label."

The Examiner also alleges that *Sansone* "teach[s] . . . a generated enhanced label (Fig. 1, elm. 22), the enhanced label comprising a routing code" (Final Office Action at p. 4). It appears that the Examiner acknowledges that *Sansone* does not teach "[an] enhanced label comprising a routing code and a label unique identifier," as recited in claim 1 (emphasis added). Indeed, as discussed in Applicant's Reply to

Office Action dated May 3, 2010, "*Sansone* discloses that 'a label is printed that identifies the mail in [a] tray for subsequent routing' *Sansone*, col. 1, ll. 49-51. *Sansone* also discloses label 29 and tag 32 that include various [routing] information" (citing *Sansone*, col. 4, ll. 21-43) (Reply to Office Action dated May 3, 2010, at p. 11). It follows that because *Sansone* does not teach or otherwise suggest "[an] enhanced label comprising a routing code and a label unique identifier," *Sandone* also fails to teach or otherwise suggest "generating an enhanced label, the enhanced label comprising a routing code and a label unique identifier, wherein the enhanced label is unique within a predetermined time period so that additional labels generated within the predetermined time period are distinguishable from the enhanced label."

Further, the Examiner admits that "[n]either *Radican* or *Sansone* teach specifically to the enhanced label being unique within a predetermined time period." (Final Office Action at p. 4). The Examiner instead, relied on improper Official Notice as allegedly teaching the above-listed elements. (*Id*).

The Official Notice is improper at least because the Examiner has taken Official Notice of facts not in the record, without direct reliance on a cited prior art reference in support of this rejection. See M.P.E.P. § 2144.03. "Official notice unsupported by documentary evidence should *only* be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of *instant and unquestionable* demonstration as being well-known." *Id.* at § 2144.03(A) (emphases added). Otherwise, "[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference." *Id.* Furthermore, if Official Notice is taken of a fact that is asserted to be well-known unsupported by documentary evidence, "[t]he

examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." *Id.* at § 2144.03(B).

In this case, the Final Office Action's alleged facts are not well-known, not common knowledge, and are not capable of instant and unquestionable demonstration as being well-known. Furthermore, the Final Office Action's assertion of well-known fact is not supported by documentary evidence, because the cited references do not teach or suggest the elements of claim 1, as admitted by the Final Office Action at p. 4. Under this circumstance, M.P.E.P. § 2144.03(B) requires the Examiner to provide "specific factual findings predicated on sound technical and scientific reasoning to support his conclusion of common knowledge" (emphasis added). The Final Office Action, however, has failed to provide any "sound technical and scientific reasoning" to support a conclusion of common knowledge, as required by the M.P.E.P.

Applicant respectfully submits that because *Radican* and *Sansone* fail to disclose or suggest all of the elements of the claims, and the Official Notice (which is improperly taken and includes factual error) does not remedy the deficiencies of *Radican* and *Sansone*, the combination of these cannot result in the combination of claim 1. Moreover, the undisclosed elements represent significant differences between the teachings of the references and claim 1, as a whole, which render claim 1 nonobvious. See M.P.E.P. § 2141. For at least these reasons, independent claim 1 and claims 2-6 and 19 that depend therefrom, are in condition for allowance. Claims 2-6 and 19 are also allowable because they recite additional elements not taught nor suggested by the cited art.

Independent claims 7, and 13, while having a scope different from that of claim 1, includes recitations similar to those discussed above regarding claim 1. Therefore, for reasons at least similar to those set forth with respect to claim 1, claims 8-12, 14-18, and 20 that depend from their respective independent claims are also in condition for allowance. Dependent claims 8-12, 14-18, and 20 are also allowable because they recite additional elements neither taught nor suggested by the cited art.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-20 under 35 U.S.C. § 103(a).

Conclusion

In view of the above, Applicant respectfully requests reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____

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